THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH HOLMES

Appeal No. 96-3077
Application No. 08/255,544[1]

ON BRIEF

Before HAIRSTON, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-4, 6-12, 14-20, 22-27, and 29, all of the claims pending in the present application.

The claimed invention relates to the passing of messages between objects in an object oriented programming system.

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[1] Application for patent filed June 6, 1994. According to appellant, this application is a continuation of Application 07/717,450, filed June 19, 1991, now abandoned.

More specifically, Appellant discloses on page 3 of the specification that messages are passed through a filter which detects the type of message being sent and determines the most appropriate path for transferring the message. As illustrated in Figs. 2 and 3 of the drawings, if a system message is detected, the message is transmitted utilizing system message handling. If a system message is not detected, the message is transferred using a direct call.

Representative claim 1 is reproduced as follows:

1. A data processing apparatus for executin two or more computer programs, said data processing apparatus including memory and processor means, said two or more computer programs each including a plurality of objects having data and program code for manipulating said data, said apparatus comprising:

message path means for transferring a message between a sending and a receiving object, said message having a message type and message content, said message path means including a first message transfer means for transferring said message between objects within the same computer program and a second message transfer means for transferring said message to an object in a computer program different from the computer program of the sending object; and

message path selection logic external to said sending and receiving objects and responsive to said message type of said message being transferred by said message path means to select said first or second message transfer means for transferring said message between said objects.

The Examiner relied on the following reference:

Gammage, N. et al. 'XMS: A Rendezvous-Based Distributed System Software Architecture.' IEEE Software, vol. 2, no. 3 (May 2, 1985), pp. 9-19.

Claims 1-4, 6-12, 14-20, 22-27, and 29 are rejected under 35 U.S.C. § 103 as being unpatentable over the Gammage et al article.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief and Answer for the respective details thereof.

We will not sustain the rejection of claims 1-4, 6-12, 14-20, 22-27, and 29 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***,

73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied,*** 117 S.Ct. 80 (1996) ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

At the outset we note that the Examiner's position set forth in the final rejection is that, while Gammage et al. do not specifically discuss a message path selection feature, it would have been obvious to one of ordinary skill that a path selection based on message type would be necessary for operation of the system of Gammage et al. Appellant's response to the rejection of the claims under 35 U.S.C. § 103 as unpatentable over Gammage et al. argues that any selection mechanism in Gammage et al. is internal to the sending task and not external as claimed. We note that Appellant's claim 1 recites

> message path selection logic external to said sending and receiving objects and responsive to said message type of said message being transferred by said message path means to select said first or second message transfer means for transferring said message between said objects.

Appellant argues on pages 11 and 12 of the Brief with respect to

the Gammage et al. reference

> The inclusion of a “locale and node” in the “remote taskid” provides routing information within that taskid. Thus the routing is internal in the sending task and not external as presently claimed.

In response to this argument by Appellant, the Examiner (Answer, pages 4 and 5) initially points to statements in Appellant’s Brief and in Gammage et al. relating to transparency between communicating tasks in the system described in Gammage et al. In the Examiner’s view, the Appellant’s admission on page 9, lines 1-5 of the Brief that each task in Gammage et al. need not know the actual location of other tasks with which it wishes to communicate supports the Examiner’s position that no internal message path selection is present in Gammage et al.

After careful review, however, we are of the opinion that the Examiner has misconstrued Appellant’s statements on page 9 of the Brief and the Gammage et al. reference. We note the following statement from page 18, col. 1, lines 6-12 of Gammage et al. referenced by the Examiner

> Any task in the cluster can potentially communicate with any other task in the cluster without needing to know precisely where the other task is executing, but only whether it is executing in the same or in a different program.

In our view, this passage indicates that, while the sending task in Gammage et al. does not require the exact location of a remote task to be invoked, such sending task requires knowledge as to whether, in the terminology used by Gammage et al., a local rendezvous or a remote rendezvous is required. The discussion of local and remote rendezvous on pages 13-15 of Gammage et al. indicates that a remote task identification is required for the sending task to invoke a remote rendezvous. The inclusion of such remote task identification is effectively an internal message path selection included in the sending task definition.

The Examiner further argues (Answer, page 5) that the inclusion of "target locale and node" information in the identification of message type in Gammmage et al. is not precluded by the use of the transitional phrase "comprising" in Appellant's claim 1. On this point, while the Examiner's statement regarding preclusion is correct, we agree with

Appellant that the inclusion of locale and node information in the identification information of the remote task in Gammage et al indicates that any message path selection must necessarily be internal to the sending task.

In further response to Appellant's arguments, the Examiner refers to a "name server" discussed beginning at page 15, line 35 of Gammage et al. as providing a teaching of message routing through an "external" task (Answer, page 5). However, on review of this passage of Gammage et al., we are of the view that, while such "name server" task may be external to the sending and receiving tasks, no message path selection is taking place. The name server described by Gammage et al. on page 15 acts as a repository of remote task identification information which can be accessed by a remote task preparing to be invoked and by a sending task requiring such remote task identification information. We can find no message path selection performed by such name server in Gammage et al., since, as discussed previously, a remote rendezvous will have been internally selected by the coding of a remote task identification into the sending task definition.

With respect to independent claims 26 and 27, Appellant contends that the internal routing performed by the sending task in Gammage et al. cannot meet the claimed feature of the detection of message type independent of the first and second objects. Appellant's claim 26 recites

> detecting, independent of said first or second objects, the message type of said generated message; and
>
> transferring said message between objects via one of said plurality of message paths in response to said detected message type.

In regard to independent claim 29, Appellant reiterates the contention that Gammage et al. provides no teaching of the claimed external testing feature. Appellant's claim 29 recites

> testing the message type to determine a destination object for said message type of message routing, said testing being performed external to the generating object;

In response to the Appellant's arguments with regard to claims 26, 27, and 29, the Examiner argues (Answer, page 6)

> Applicant's arguments regarding claims 26 and 29 (pages 14-15 of the Brief) are not persuasive, because if as admitted by Appellant "the routing of Gammage et al is performed by sending task and is, therefore, not 'independent

> of' such task," such a distinction is merely the separating into two tasks/devices a process which was previously performed as integral to another process/device. Such a distinction is not patentably distinguishing, since it has held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman,* 168 USPQ 177, 179.

We have reviewed the *Nerwin* decision cited by the Examiner and find that it does not support the Examiner's position. The factual situation in *Nerwin* involved the question of whether an integral structure is precluded from being separated and considered as separate elements. To the extent there is any analogy to the internal selecting task in Gammage et al. as an integral structure, the claimed invention involves more than merely separating such task into separate tasks. The differences between the claimed invention and Gammage et al. lie in not merely the separating of an internal message path selection task into separate tasks, but rather the use of an external path selection feature to perform message path selection external to and independently of the message sending and receiving objects. In view of the above, we agree with Appellant that the Examiner has not

established a ***prima facie*** case of obviousness. In particular, we find that the Examiner has not established that external and object independent message path selection according to message type is taught or suggested in the prior art.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a ***prima facie*** case. ***In re Knapp-Monarch Co.***, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); ***In re Cofer***, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

In summary, we have not sustained any of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-4, 6-12, 14-20, 22-27, and 29 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	)	

lp

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Appeal No. 96-3077
Application No. 08/255,544

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DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): 103

Prepared: September 27, 1999

Draft Final

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